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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application No. 09/721,484

Filing Date: November 22, 2000

Appellants: Manolis et al.

REPLY TO EXAMINER'S ANSWER

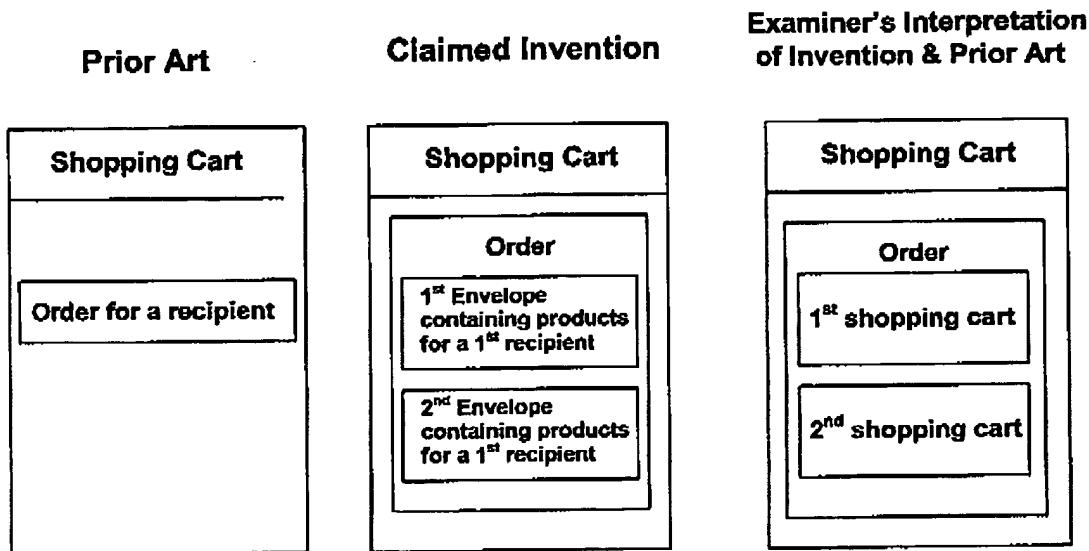
REPLY

In response to the Answer mailed 2/14/2006, Applicants responds as follows.

1. CLAIMS 31, 32, 34, 35, 36, 37, 51 AND 52 ARE NOT ANTICIPATED UNDER 35 U.S.C. 102(E) BY DODD (US 6,321,211).

Page 4 of the Answer mailed 2/14/2006 noted that:

First, the examiner would like to define what is understood to be applicant's envelope. The applicant defines on page 10, line 2 that "An envelope is a virtual storage entity for holding images that are to be printed and delivered to a single destination". Microsoft Computer Dictionary defines a shopping cart as "a file in which an online customer stores information on potential purchases". Therefore the examiner considers the old and well known electronic shopping cart to be synonymous with the applicant's envelope (see also col. 1, lines 25-44).



The appellant respectfully disagrees with the Examiner's interpretation of the term "envelope" in the instant patent application. An order can include a plurality of envelopes (such as "Self", "Poppa" as shown in Figures 21, 15, 17, 18, and 20, and described in the related discussions) for holding images to be printed and delivered to different recipients. Each envelope is a virtual storage entity for holding images that are to be printed and

delivered to a single destination. In contrast, a shopping cart is an entity that contains potential orders for online customers.

An order cannot contain several shopping carts. It is even more unreasonable to interpret that a shopping cart can contain an order that in turn contains several shopping carts within the order. The foregoing discussion and the graphic illustration constitute one basis for traversing the rejection.

Pages 9-10 of the Answer mailed 2/14/2006 noted that:

In response to appellant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., allow the user selecting one or more pictures into one or more envelopes for printing) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that Dodd fails to show "creating a plurality of envelopes and displaying each envelop on a user interface". The examiner disagrees; FIG 1 C clearly shows multiple shopping bags (envelopes) displayed on a user interface (see occasion).

Appellant argues that Dodd does not teach, "associating a selected image with two or more envelops". The examiner disagrees noting that clearly when a buyer selects the same gift or card for different recipients from the "top ten gift list" or "favorite gift list" the same gift/product ("image" is the gift/product that the instant application is forwarding), is associated with multiple shopping bags (envelopes).

Appellant argues that Dodd can receive only one item at a time. The examiner disagrees and directs the appellant's attention to FIG 1 B, item 135, Quantity.

Appellant argues that FIG 1 C does not show multiple shopping bags (envelopes. The examiner disagrees and notes that each displayed event is a separate occasion that has a separate envelope associated with the occasion.

Appellant argues that Dodd does not teach selecting an image for distribution to multiple recipients. The examiner disagrees and directs the appellant' attention to FIG 1 C, specifically "My Favorite Gifts" which expressly implies that the same gift is being selected for multiple recipients.

Applicant argues that Dodd fails to show "associating a selected image with two or more recipients. The examiner disagrees and directs the appellant' attention to FIG 1 C, specifically "My Favorite Gifts" which expressly implies that the same gift is being selected for multiple recipients.

Applicants respectfully traverse the Answer's position. Dodd's FIG. 1B fails to show the creating a plurality of envelopes and displaying each envelope on a user interface so that items can be selected and moved into each envelope. This is needed when multiple recipients are to receive prints.

Moreover, the allegedly equivalent Dodd "envelopes" are not envelopes, but are icons designed in advance and the user has to select one item at a time into a shopping bag for a user. First, even if each envelope were equivalent to a shopping cart or shopping bag as noted in the Office Action, Dodd fails to show creating a plurality of envelopes and displaying each envelope on a user interface. In Dodd, the user interface is predefined by a web designer and the user has no choice in creating and displaying envelopes on the user interface.

Dodd can only select gift(s) for ONE recipient one at a time. There is no showing that Dodd associates with each envelope an intended recipient to receive images placed in a respective envelope. This is an independent basis to traverse the Section 102 rejection.

The diagram above shows that Dodd discloses a shopping cart to receive an order for the recipient, but Dodd does not allow a user to select one or more pictures into one or more envelopes for printing. The invention provides a single order that can include a plurality of envelopes for various recipients. That single order may reside in a shopping cart. The Answer takes the hindsight position as taught by the present invention to shoehorn the prior art into the invention. However, such shoehorn analogy fails as the invention arrived at by the Examiner would provide for a plurality of shopping carts in a single order, which is illogical and is also not the claimed invention.

Further, Dodd does not show selecting an image for distribution to multiple recipients. At best, FIG. 1C shows that each item in the matrix can be associated with one recipient at a time since the "Select Recipient" drop down selection tab allows only one recipient to be selected at a time. This is yet another independent basis to traverse the Section 102 rejection.

In addition, Dodd fails to show "associating a selected image with two or more envelopes." FIG. 1C shows a number of images, but does not show two or more envelopes. If each envelope were a shopping cart (as asserted by the Office Action), there is no showing in Dodd that a plurality of shopping carts are available for selecting

an image for distribution to multiple recipients; and associating a selected image with two or more envelopes.

Thus, it is quite clear that Dodd fails to show each and every element of claim 31 and thus cannot anticipate claim 31. For claim 32, since Dodd shows only one shopping cart, Dodd cannot show displaying along with each envelope an identifier associated with the name of a recipient. Similarly, for claim 33, Dodd fails to show displaying along with each envelope a running price associated with the total price of images placed in a respective envelope. For claim 34, Dodd does not show a checkbox with each image, the checkbox for designating an image to be included in an order as FIG. 1B's 130 is a button, not a checkbox. For claim 35, Dodd fails to show placing an instance of the image in each envelope associated with an intended recipient since Dodd has only one shopping cart. For claim 36, Dodd fails to show an add button or link associated with each envelope, the add button, when invoked, operable to add a copy of each selected image to a respective envelope. For claim 37, Dodd fails to show selecting an add button or link associated with an envelope of an intended recipient. As to claim 51, Dodd fails to show processing all of the envelopes as a single order since Dodd has only one shopping cart. For claim 52, Dodd does not show email confirmation with a summary of each envelope since Dodd has only one shopping cart.

Withdrawal of the Section 102 rejection on all claims is requested.

2. CLAIMS 33, 38, 39, 40, 53 AND 54 ARE PATENTABLE UNDER 35 U.S.C. 103(A) OVER DODD IN VIEW OF OFFICIAL NOTICE.

Claims 33, 38-40 and 53-54 were rejected under Section 103(a) as unpatentable over Dodd in view of Official Notice. As discussed above, Dodd fails to show creating a plurality of envelopes and displaying each envelope on a user interface; associating with each envelope an intended recipient to receive images placed in a respective envelope; displaying on the user interface one or more images along with the plural envelopes; selecting an image for distribution to multiple recipients; and associating a selected image with two or more envelopes. Hence, the independent claims are patentable over Dodd.

and the dependent claims are allowable on this basis. As to the Official Notice, references should be provided or the rejection based on the Official Notice be withdrawn.

Applicants note that no motivation or suggestion, either in the cited art reference or in the knowledge generally available to one of ordinary skill in the art, has been cited by the Examiner to modify the Dodd reference so as to produce the claimed invention. In fact, the Dodd reference teaches away from Applicants' invention as one skilled in the art would have been generally discouraged from using shopping carts to provide creating a plurality of envelopes and displaying each envelope on a user interface; associating with each envelope an intended recipient to receive images placed in a respective envelope; displaying on the user interface one or more images along with the plural envelopes; selecting an image for distribution to multiple recipients; and associating a selected image with two or more envelopes.

The Final Office Action noted that the above arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patently distinguishes them from the references. Applicant respectfully disagrees as the absence of each element has been abundantly discussed above in the traversal of the Section 102 rejection and need not be repeated herein.

Applicant points out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to any evidence in Dodd, or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching so as to produce the claimed invention of claims 33, 38-40 and 53-54. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings).

Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Dodd reference, or knowledge of those skilled in the art, to perform the recited claim operation, *prima facie* obviousness of the rejected claims has not been established. As such, it is respectfully requested that the § 103 rejection be withdrawn and the claims be allowed.

3. CLAIMS 41-44 ARE PATENTABLE UNDER 35 U.S.C. 103(A) OVER DODD IN VIEW OF SHARP (ET AL. (US 6,263,317)).

Claims 41-44 were rejected under 35 U.S.C. 103(a) as being unpatentable over Dodd in view of Sharp (et al. (US 6,263,317)). In regards to claim 41, the Office Action noted that Dodd teaches making a purchase and a shopping bag, but does not mention that the system includes an order details button that summarized the purchases being made. Sharp teaches an order details button that can be used to present to the user a summary of a plurality of purchases (FIG 13).

First, as discussed above, Dodd does not teach a method for designating multiple recipients for an image at an on-line print service by creating a plurality of envelopes and displaying each envelope on a user interface; associating with each envelope an intended recipient to receive images placed in a respective envelope; displaying on the user interface one or more images along with the plural envelopes; selecting an image for distribution to multiple recipients; and associating a selected image with two or more envelopes. Sharp fails to show these elements as well. Hence, this is one basis for traversing the rejection.

Further, it would not have been obvious to a person having ordinary skill in the art at the time of the invention to include in Dodd the order details button as taught by Sharp. The combination of the references was arrived at using hindsight afforded by the teachings of the invention. As to claim 41, Dodd's FIG. 13 fails to show the specifics of displaying on the user interface an order details button for each envelope, the order details button operable to display, when invoked, a envelope summary, the envelope summary including a representation of each image selected and a size and quantity data for each

image, the size data indicative of the size of the image print to be printed and the quantity data indicative of the number of prints of a given size to be included in a given order.

In regards to claim 42, Dodd's FIG. 2A does not teach the envelope, and certainly that the envelope summary includes a message to be printed on the print. In regards to claim 43, Dodd's FIG. 1C does not teach that the envelope summary includes a preview of the print including as ordered including any user-designated effects (FIG 1 C). In regards to claim 44, Dodd fails to teach changing an order for an intended recipient when reviewing the envelope summary and automatically recalculating the price and quantity data displayed on the user interface for an associated envelope.

As such, it is respectfully requested that the § 103(a) rejection of the claims be withdrawn and the claims be allowed.

4. CLAIM 45 IS PATENTABLE UNDER 35 U.S.C. 103(A) OVER DODD IN VIEW OF SPIEGEL ET AL (6,629,079).

Claim 45 was rejected under 35 U.S.C. 103(a) as being unpatentable over Dodd as in view of Spiegel et al (6,629,079). Spiegel relates to system that provides multiple electronic shopping carts for each user. Each electronic shopping cart has an indication of items currently within the electronic shopping cart and billing and shipment information. The system generates a display that identifies each of the electronic shopping carts and sends the generated display to a user computer system. The system then receives a selection of one of the identified electronic shopping carts from the user computer system and receives a selection of an item from the user computer system. In response to receiving the selection of the item, the system adds the item to the selected electronic shopping cart. The system then receives an indication to checkout the items in the selected electronic shopping cart from the user computer system. In response to receiving the indication to checkout, the system ships the items in the selected electronic shopping cart in accordance with the shipment information of the selected electronic shopping cart and bills for the items in the selected electronic shopping cart in accordance with the billing information for the selected electronic shopping cart. The system thus allows a

user to select each of the electronic shopping carts for adding items to each electronic shopping cart.

However, the combination does not render obvious claim 45. As discussed above, Dodd does not teach a method for designating multiple recipients for an image at an on-line print service by creating a plurality of envelopes and displaying each envelope on a user interface; associating with each envelope an intended recipient to receive images placed in a respective envelope; displaying on the user interface one or more images along with the plural envelopes; selecting an image for distribution to multiple recipients; and associating a selected image with two or more envelopes. Spiegel fails to show these elements as well. Hence, this is one basis for traversing the rejection.

Further, it would not have been obvious to a person having ordinary skill in the art at the time of the invention to include in Dodd the order details button as taught by Spiegel. Spiegel does not show the envelopes, and the combination does not show an order button on the user interface along with the envelopes and image selections, the order button operable, when selected, to place an order in accordance with the envelopes specified on the user interface for plural recipients from a single user interface page.

Hence, claim 45 is patentable over Dodd and Spiegel. As such, it is respectfully requested that the § 103(a) rejection of the claim be withdrawn and the claim be allowed.

**5. CLAIMS 46-50 AND 55-64 ARE PATENTABLE UNDER 35 U.S.C. 103(A)
OVER DODD IN VIEW OF SHARP IN VIEW OF SPIEGEL AND FURTHER
IN VIEW OF OFFICIAL NOTICE.**

In regards to claim 46-50 and 55-64, Dodd does not teach a method for designating multiple recipients for an image at an on-line print service by creating a plurality of envelopes and displaying each envelope on a user interface; associating with each envelope an intended recipient to receive images placed in a respective envelope; displaying on the user interface one or more images along with the plural envelopes; selecting an image for distribution to multiple recipients; and associating a selected image with two or more envelopes. Spiegel and the Official Notice fail to show these elements

as well. Hence, this is one basis for traversing the rejection. Moreover, Dodd fails to show displaying an order summary in a single summary user interface for plural recipients, the order summary including plural entries, one for each envelope specified in the user interface. Hence, this claim is allowable.

In regards to claim 47, as discussed above, the Office Action admitted that the combination of Dodd/Sharp/ Spiegel/Official Notice teaches listing items on a single page and totaling a price, but this combination does not specifically mention that the price includes cost for selected shipping expenses. Hence, the rejection on these claims should be withdrawn.

In regards to claim 50, the Office Action admitted that the combination of Dodd/Sharp/Spiegel/Official Notice additionally fails to point out that the method of Dodd is adding up multiple shopping carts on display. This is an additional basis for traversing the rejection.

As such, it is respectfully requested that the § 103(a) rejection of the claims be withdrawn and the claims be allowed.

CONCLUSION

For the foregoing reasons, Applicants request withdrawal of all rejections and objections and that all claims be allowed.

Respectfully submitted,

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